

REMARKS

I. Status of the claims

After entering this amendment, claims 1, and 3-14 will be pending in this application. Claims 2 and 3 have been cancelled in this amendment without prejudice or disclaimer. Claim 1 has been amended to incorporate the subject matter of original claim 3. Claim 5 has been amended to be consistent with the amendment made to claim 1. These amendments find support in the original claims and the specification, for example, in original claim 3. Accordingly, no new matter has been introduced by these amendments.

II. Rejection under 35 U.S.C. § 103

The Office rejected claims 1-14 under 35 U.S.C. 103(a) as being unpatentable over U. S. Patent Application Publication No. 2004/0103130 ("*Ivanisevic*") in view of Peterson et al., "Improved measures of quality for the atomic pair distribution function," *J. Appl. Cryst.* 36:53-64 (2003) ("*Peterson*").

Without commenting on the merits of the combination or acquiescing to the Office's characterization of the cited references, Applicants traverse this rejection at least because *Ivanisevic* is not proper prior art to this application pursuant to 35 U.S.C. § 103(c).

35 U.S.C. § 103(c) states that subject matter that qualifies as prior art only under 35 U.S.C. §§ 102(e), (f), and/or (g) can be disqualified as prior art against a claimed invention if that "subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person." 35 U.S.C. § 103(c)(1); *see also* M.P.E.P. § 706.02(I).

Common ownership may be established by a conspicuous statement indicating that the claimed invention and a § 102(e) reference were, at the time the invention was made, commonly owned or subject to an obligation of assignment to the same person. M.P.E.P. § 706.02(I)(2)(II).

Statement of Common Ownership

Ivanisevic qualifies only as 102(e) prior art against the instant application. Therefore, in an effort to expedite prosecution, and under the provisions of 35 U.S.C. § 103(c), Applicants' undersigned representative supplies the following statement of common ownership.

Ivanisevic and the instant application were both, at the time the present invention was made, either owned by the same company, S.S.C.I., Inc., or subject to an obligation of assignment to S.S.C.I., Inc.

As a result, *Ivanisevic* is not applicable prior art under 35 U.S.C. § 103 against the present application. Accordingly, the present rejection is now moot and Applicants respectfully request that it be withdrawn.

Applicants acknowledge the Office's statement regarding WO 2004/013622 disclosing the same invention as *Ivanisevic*. Office Action at 8. WO 2004/013622 qualifies as 102(a) prior art but was not relied on in the instant rejection. *Id.* Should the Examiner decide to use WO 2004/013622 in a subsequent prior art rejection, Applicants reserve the right to present arguments or evidence, e.g., showing a date of invention for the present claims prior to the publication date of WO 2004/013622, in order to establish the patentability of the pending claims over WO 2004/013622.

III. Information Disclosure Statement

Applicants thank the Office for initialing the SB/08 forms of the Information Disclosure Statements filed on May 4, 2007, and August 8, 2007, and returning them to Applicants. Applicants filed an additional Information Disclosure Statement on July 30, 2008, a few days after the mailing of the present Office Action. Applicants respectfully request that the Office consider those references and then initial and return the corresponding SB/08 form to Applicants.

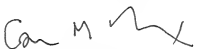
IV. Conclusion

In view of the foregoing remarks, Applicants respectfully request reconsideration of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

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